REMARKS

Reconsideration of this application, as presently amended, is respectfully requested. Claims 1-5 and 11-25 are pending in this application. Claims 1-5 and 11-25 stand rejected.

Request for Withdrawal of Finality of Office Action

It is respectfully submitted that, although the Examiner has withdrawn the previous final rejection of the claims, the Examiner has **improperly** issued the present Office Action as a **final** Office Action. More specifically, the Manual of Patent Examining Procedure (MPEP) §706.07(a), states:

> Under present practice, second or any subsequent actions on the merits shall be final, ***except where the Examiner introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)***.
>
> Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will ***not be made final if it includes a rejection, on newly cited art***, other than information submitted an Information Disclosure Statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), ***of any claim not amended by Applicant*** or patent owner in spite of the fact that other claims may have been amended to require newly cited art. [emphasis added]

It is submitted that the present Office Action issues new grounds of rejection on newly cited art, which new grounds of rejection were neither necessitated by applicant's amendment of the claims nor based on information submitted in an Information Disclosure Statement. More

specifically, in the Request for Reconsideration filed on September 16, 2006, the claims were ***not*** amended. The current rejections of the claims under §103 apply the newly cited **Lord et al.** reference (USP 6,944,877), which reference was not previously cited against the claims.

Accordingly, the finality of the present Office Action is improper and should be withdrawn. The Examiner should properly consider the current Office Action a non-final Office Action.

Claim Rejections – 35 U.S.C. §103

Claims 1-5 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Thibadeau** (USP 5,565,909, previously cited) in view of **Lord** (USP 6,944,877).

Claims 11-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Thibadeau** and **Lord**, as applied to claims 1-5 above, and further in view of **Eldering** (US 2002/0178445, previously cited).

Claims 16-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Thibadeau** and **Lord**, as applied to claims 1-5 above, and further in view of **Wright** (USP 33, 808, previously cited).

Claims 21-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Thibadeau** and **Lord**, as applied to claims 1-5 above, and further in view of **Zigmond** (USP 6,698,020).

For the reasons discussed in detail below, these rejections are respectfully traversed.

Initially, it is noted that claim 1 has been amended to recite "*wherein said controller feeds to said video/audio output means the advertising information selected ~~when~~ by the contrast between the information related to the current position and the advertising area information in response to said judgment means ~~judges~~ judging that the video and audio which are currently being output are a commercial*" to clarify the differences between the cited references and the present invention. It is submitted that these amendments are clarifying amendments that do not change the scope of the claim.

The **Thibadeau** reference was discussed in detail in the previous two responses. Therefore, a detailed discussion of **Thibadeau** will not be repeated here. However, the comments regarding **Thibadeau** set forth in the previous two responses are hereby incorporated by reference.

As discussed in the previous responses, applicants basically agree with the Examiner's statement on page 3, lines 14-21 of the Office Action that **Thibadeau** does ***not*** disclose or suggest "*judgment means for judging whether or not video and audio which are being currently outputted are a commercial (CM) appended to a program, wherein said controller feeds to said video/audio output means the advertising information selected by the contrast between the information related to the current position when said judgment means judges that the video and audio which are currently being output are a commercial.*"

More specifically, **Thibadeau** discloses a set-top receiver that allows a user to enter a geographic code into a data processor coupled to the receiver to define the user's selected locations of interest. Transmitted messages or information include location designation codes

accompanying location specific messages. The processor receives a message and an accompanying location designation code and compares the designated location to the user's selected location. The processor processes (e.g., displays) messages or information when there is overlap between the designated location and the user's selected location.

Thus, **Thibadeau** teaches a system that provides a user information based on an entered geographic code. As discussed in previous responses, **Thibadeau** does not disclose or suggest the claimed "judgment means..." and the claimed operation of the "controller" in response to the judging a commercial is being output.

The Examiner relies on the **Lord et al.** reference to teach the above-noted features that are not disclosed by **Thibadeau.**

The **Lord et al.** reference discloses a system for replacing the regular advertisements in a broadcast video signal (e.g., a television broadcast) with audience specific advertisements. The **Lord et al.** system includes receiver circuitry capable of receiving an incoming television signal. The incoming television signal from a cable provider includes a swap control signal associated with a corresponding channel. The swap control signal indicates that an original commercial advertisement is about to be shown (on a television screen) on the corresponding channel. See, e.g., col. 4, lines 59-65.

A local storage device coupled to the receiver circuitry stores a plurality of replacement video advertisements. An advertisement controller is coupled to the receiver circuitry and to the local storage device. The advertisement controller detects a swap control signal transmitted in the incoming television signal and, in response to the detection, causes the receiver circuitry to

receive from the local storage device a selected replacement video advertisement. See, e.g., col. 2, lines 15-33; col. 4, line 65 – col. 5, line 9; and col. 7, lines 51-59.

The replacement advertisements may be downloaded from the cable provider to a hard disk (local storage device). In accordance with one embodiment of **Lord et al.**, the replacement commercial advertisements are downloaded from one or more system defined channels (see col. 6, lines 49-55). In accordance with another embodiment, the cable service provider may customize the replacement advertisements by transmitting ad selection commands to the advertising controller. The ***ad selection commands***, which may accompany the swap signals, are used by the advertisement controller ***to select particular replacement commercial advertisements*** from the available advertisements stored on the hard disk (see col. 6, line 65 – col. 7, line 5).

Although it may be reasonable for the Examiner to assert that **Lord et al.** discloses the claimed "judgment means...", it is respectfully submitted that the **Lord et al.** reference does **not** disclose or suggest the claimed controller "*wherein said controller feeds to said video/audio output means the advertising information selected by the contrast between the information related to the current position and the advertising area information when said judgment means judges that the video and audio which are currently being output are a commercial*".

More specifically, the **Lord et al.** reference discloses that the incoming television signal from a cable provider includes a swap control signal associated with a corresponding channel, and that ***the swap control signal indicates that an original commercial advertisement is about to be shown*** (on a television screen) on the corresponding channel. See, e.g., col. 4, lines 59-65.

The advertisement controller detects a swap control signal transmitted in the incoming television signal and, in response to the detection, causes the receiver circuitry to receive from the local storage device a selected replacement video advertisement. See, e.g., col. 2, lines 15-33; col. 4, line 65 – col. 5, line 9; and col. 7, lines 51-59.

Thus, although it may be reasonable that the swap control signal in combination with the advertisement controller operates as a "*judgment means for judging whether or not video and audio which are being currently outputted are a commercial (CM) appended to a program*", **Lord et al.** do not disclose the operation of the claimed controller.

Specifically, the **Lord et al.** reference does not disclose or suggest the claimed controller "*wherein said controller feeds to said video/audio output means the advertising information selected by the contrast between the information related to the current position and the advertising area information in response to said judgment means judging that the video and audio which are currently being output are a commercial*".

Unlike the claimed invention, according to **Lord et al.**, "in response to judging that the video and audio which are currently being output are a commercial", the **Lord et al.** system replaces the detected commercial advertisement with *a replacement advertisement that has been previously downloaded from the cable provider and stored in hard disk.* The **Lord et al.** reference is silent regarding a controller that "*feeds to said video/audio output means the* ***advertising information selected by the contrast between the information related to the current position and the advertising area information*** *in response to said judgment means judging that the video and audio which are currently being output are a commercial*".

Lord et al. only discloses that the cable service provider may customize the replacement advertisements by transmitting ad selection commands to the advertising controller. The ***ad selection commands***, which may accompany the swap signals, are used by the advertisement controller ***to select particular replacement commercial advertisements*** from the available advertisements stored on the hard disk (see col. 6, line 65 – col. 7, line 5). However, in **Lord et al.**, the ad selection commands to select replacement advertisements ***are unrelated to selecting a replacement advertisement by the contrast between the information related to the current position and the advertising area information***.

Thus, **Lord et al.** does not alleviate the deficiencies of **Thibadeau**. Accordingly, the combination of references does not result in the invention as recited in independent claims 1, 2 and 5. Each of claims 11-15, 16-20 and 21-25 depend either directly or indirectly from claims 1, 2 and 5. It is submitted that each of the dependent claims is allowable for the same reasons set forth above with respect to the independent claims by virtue of their dependency thereon.

CONCLUSION

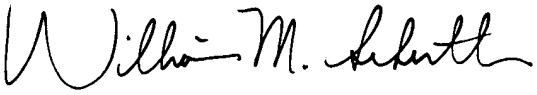
In view of the foregoing amendments and accompanying remarks, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



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